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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/690,485 10/17/00 FALLON

K END910996013

026681 MMC1/0815  
DRIGGS, LUCAS BRUBAKER & HOGG CO. L.P.A.  
DEPT. IEN  
8522 EAST AVENUE  
MENTOR OH 44060

EXAMINER

NORRIS, J

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 08/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/690,485	FALLON ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Jeremy Norris	2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-9 and 16-20 is/are pending in the application.

4a) Of the above claim(s) 1-9 and 16-18 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 19-20 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s)      6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 16-18, drawn to a method of making a printed circuit card, classified in class 29, subclass 852.
- II. Claims 19-29, drawn to a printed circuit card, classified in class 174, subclass 262.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the conductive material in the invention of group II could be formed by vapor deposition as opposed to additive plating as claimed in the invention of group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. William Hogg on 31 July 2001 a provisional election was made without traverse to prosecute the invention of group II,

claims 19-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by Bhatt et al. (US 5,822,856).

Bhatt et al (hereafter Bhatt) discloses, referring to figures 3-5, a printed circuit card comprising a metal layer (wiring layer 306) sandwiched between a pair of dielectric layers (310 & 312), said dielectric layers being formed of a photoimaged cured dielectric material (see the abstract), metalization on each of the first and second layers of the photoimageable material, and metal filled vias (hole 332, only one shown but a plurality referred to) in the first layer of photoimageable material (312) connected to the circuitry and the metal layer, and an opening (hole 328) in the metal layer and in the first and second layers of photoimageable material, the opening being metallized to connect at

least a portion of the circuitry on the first layer with a portion of circuitry on the second layer without contacting the metal layer.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatt et al.

Bhatt discloses the claimed invention as described above with respect to claim 19 except for the limitation that Bhatt does not specifically state that the holes and vias in the dielectric material be photoformed. However, this limitation is a process limitation in a product claim and cannot serve to patentably define the product over the prior art of record. Furthermore, it is well settled that the presence of process limitations

in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product (*In re Johnson*, 157 USPQ 670, 1968)..

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents disclose multilayered boards with voltage planes:

US 5,774,340	Chang et al.,
US 5,640,048	Selna,
US 5,448,020	Pendse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7724 for regular communications and 703-305-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN  
August 9, 2001



A handwritten signature in black ink, appearing to read "Jeremy Norris", is positioned over a faint, rectangular stamp. The stamp contains the text "U.S. Patent and Trademark Office" and "SEARCHED, SERIALIZED, INDEXED, FILED".